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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,490	07/26/2001	Michael Wayne Brown	AUS920010396US1	6710

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IBM CORP (AP)
C/O AMY PATTILLO
P. O. BOX 161327
AUSTIN, TX 78716

EXAMINER
GOLD, AVI M

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 March 2006_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,3,5-9,12-14,16-20,23-25,27-31,34-39,41-44,46-49 and 54-56_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,3,5-9,12-14,16-20,23-25,27-31,34-39,41-44,46-49 and 54-56_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

This action is responsive to the appeal brief filed on March 14, 2006. Claims 1,

3, 5-9, 12-14, 16-20, 23-25, 27-31, 34-39, 41-44, 46-49, and 54-56 are pending.

Response to Amendment

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-5, 8-16, 19-27, and 30-56 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chang et al., U.S. Patent No. 6,105,012, in view of Tang et al., U.S.

Patent No. 6,532,477, further in view of Wong et al., U.S. Patent No. 6,978,293.

Chang teaches the invention substantially as claimed including a method and

apparatus for securely transmitting transactions from an application program (see

abstract).

Regarding claims 1 and 25, Chang teaches a method, in at least one server

system for enabling at least one messaging session via a network between at least a

selection of a plurality of separate client systems communicatively connected to said

network, and program for recording a messaging session, said method comprising the

steps of:

applying a separate distinguishable digital watermark to each of a plurality of

message entries communicated within a messaging session, wherein each said

separate distinguishable digital watermark identifies a separate origin of said message

entry from among said plurality of separate client systems (fig. 1, fig. 2, col. 4, lines 21-

31, Chang discloses messages given a digital signature); and

recording a log of said messaging sessions, wherein said log comprises said

plurality of messaging entries with each said separate distinguishable watermark

applied, such that an origin of each of said plurality of message entries stored in said

log is traceable and the integrity of each of said plurality of message entries stored in

said log is verifiable according to said distinguishable watermark (col. 5, lines 55-67,

Chang discloses an audit trail that keeps track of users and their digital signatures on

messages and a digital signature signifying a particular user which identifies the origin

of the message, col. 2, line 62 – col. 3, line 4, Chang discloses the storage of a users

public key to verify a digital signature).

Chang fails to teach the limitation further including the use of a digital watermark

on messages in a chat messaging system and a messaging server communicatively

connected to a network, said messaging server for enabling at least one real time chat

messaging session channel via said network between at least a selection of a plurality

of client systems communicatively connected to said network to facilitate said

messaging session.

However, Tang teaches a method and an apparatus for generating an audio

signature for a data item based on a source identifier associated with the data item (see

abstract). Tang teaches the use of an audio signature attached to a data item in an instant messaging system (abstract; col. 1, line 59 – col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the message originated from.

Chang and Tang fail to teach the limitation further including a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Wong teaches systems and methods for selecting criteria for a successful acknowledgment message criteria in instant messaging (see abstract). Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51).

Regarding claim 3, Chang teaches the method for recording a messaging session according to claim 1, said method further comprising the step of:

Applying each said separate distinguishable digital watermark and recording said log of said chat messaging session with said plurality of messaging entries at a particular client system from among said plurality of client systems (fig. 1, fig. 2, col. 1, lines 55-65, col. 8, lines 31-38, Chang discloses a digital signature created on the client computer).

Regarding claims 5, 16, and 27, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said step of applying a separate distinguishable digital watermark further comprising the step of:

applying a separate textual watermark to each of said plurality of message entries within said messaging session (col. 4, lines 21-31).

Regarding claims 8, 19, and 30, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

transmitting said log of said chat messaging session to a plurality of users participating in said messaging session (col. 4, lines 21-31, col. 5, lines 55-67, col. 8, lines 59-66, Chang discloses processing requests and transactions from the user which includes their digital signatures).

Regarding claims 9, 20, and 31, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

storing said log of said messaging session in a log file repository for tracing said origin of said plurality of message entries according to each said separate distinguishable watermark (col. 5, lines 55-67, Chang discloses an audit trail).

Regarding claims 12, 23, and 34, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

applying each said separate distinguishable digital watermark in response to a user request received from at least one from among said plurality of client systems to record said plurality of messaging entries with watermarking (col. 2, lines 19-29, Chang discloses a message digitally signed when requested).

Regarding claims 13, 24, and 35, Chang teaches the method, system, and program for recording a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

applying said distinguishable watermark to a plurality of message entries already recorded in a second log of said messaging session (col. 2, lines 19-29, col. 4, lines 21-31).

Regarding claim 14, Chang teaches a system for recording a messaging session, said system comprising:

said messaging server further comprising:

means for applying a separate distinguishable digital watermark to each of a plurality of message entries communicated within said messaging session, wherein each said separate distinguishable digital watermark identifies a separate origin of said message entry from among said plurality of separate client systems (fig. 1, fig. 2, col. 4, lines 21-31); and

means for recording a log of said messaging session, wherein said log comprises said plurality of messaging entries with each said separate distinguishable watermark applied, such that an origin of each of said plurality of message entries stored in said log is traceable and the integrity of each of said plurality of message entries stored in said log is verifiable according to said distinguishable watermark (col. 2, line 62 – col. 3, line 4; col. 5, lines 55-67).

Chang fails to teach the limitation further including the use of a digital watermark on messages in a chat messaging system and a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Tang teaches the use of an audio signature attached to a data item in an instant messaging system (abstract; col. 1, line 59 – col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the message originated from.

Chang and Tang fail to teach the limitation further including a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51).

Regarding claims 36, 41, and 46, Chang teaches the method, system, and

program for participating in a messaging session, said method, system, and program

further comprising the step of:

receiving a recording of said messaging session, wherein said plurality of

message entries for said messaging session are watermarked, such that use of said

recording of said messaging session is traceable according to a watermark (col. 5, lines

55-67).

Chang fails to teach the limitation further including the use of a digital watermark

on messages in a chat messaging system and a messaging server communicatively

connected to a network, said messaging server for enabling at least one real time chat

messaging session channel via said network between at least a selection of a plurality

of client systems communicatively connected to said network to facilitate said

messaging session.

However, Tang teaches the use of an audio signature attached to a data item in

an instant messaging system (abstract; col. 1, line 59 – col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Chang in view of Tang to use a digital watermark on messages in a

chat messaging system. One would be motivated to do so because the signatures can

convey where and whom the message originated from.

Chang and Tang fail to teach the limitation further including a messaging server

communicatively connected to a network, said messaging server for enabling at least

one real time chat messaging session channel via said network between at least a

selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51).

Regarding claims 37, 42, and 47, Chang teaches the method, system, and program for participating in a messaging session according to claims 36, 41, and 46, said method, system, and program further comprising the step of:

requesting said recording of said messaging session with watermarking of said plurality of message entries (col. 2, lines 19-29, col. 4, lines 21-31).

Regarding claims 38, 43, and 48, Chang teaches the method, system, and program for participating in a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

Participating in said messaging session by entering a messaging entry for distribution by said messaging server to said plurality of client systems through said messaging session channel (col. 4, lines 21-31, col. 5, lines 55-67, col. 8, lines 59-66).

Regarding claims 39, 44, and 49, Chang teaches the method, system, and program for participating in a messaging session according to claims 1, 14, and 25, said method, system, and program further comprising the step of:

participating said messaging session by transmitting watermarked message entries for distribution by said plurality of users participating in said messaging session (col. 4, lines 21-31, col. 5, lines 55-67, col. 8, lines 59-66).

Regarding claims 54 and 56, Chang teaches a method and program for protecting message transmissions, said method and program comprising the step of:

detecting a new message entry entered at a client messaging system; and

applying a watermark to said new message entry prior to transmission for distribution within a messaging session, such an origin of said new message entry is traceable to said client messaging system (fig. 1, fig. 2, col. 4, lines 21-31, col. 5, lines 55-67).

Chang fails to teach the limitation further including the use of a digital watermark on messages in a chat messaging system and a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality

of client systems communicatively connected to said network to facilitate said messaging session.

However, Tang teaches the use of an audio signature attached to a data item in an instant messaging system (abstract; col. 1, line 59 – col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the message originated from.

Chang and Tang fail to teach the limitation further including a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Wong teaches an instant messaging server with a plurality of clients (fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang and Tang in view of Wong to use a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session. One would be motivated to do so because it enables much faster electronic communication (col. 1, lines 50-51).

Regarding claim 55, Chang teaches a system for protecting message transmissions, said system comprising:

means for detecting a new message entry entered at said client messaging system; and

means for applying a watermark to said new message entry prior to transmission for distribution within said messaging session, such that an origin of said new message entry is traceable to said client messaging system (fig. 1, fig. 2, col. 1, lines 55-65, col. 4, lines 21-31, col. 5, lines 55-67).

Chang fails to teach the limitation further including the use of a digital watermark on messages in a chat messaging system and a messaging server communicatively connected to a network, said messaging server for enabling at least one real time chat messaging session channel via said network between at least a selection of a plurality of client systems communicatively connected to said network to facilitate said messaging session.

However, Tang teaches the use of an audio signature attached to a data item in an instant messaging system (abstract; col. 1, line 59 – col. 2, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chang in view of Tang to use a digital watermark on messages in a chat messaging system. One would be motivated to do so because the signatures can convey where and whom the message originated from.

Chang and Tang fail to teach the limitation further including a messaging server

communicatively connected to a network, said messaging server for enabling at least

one real time chat messaging session channel via said network between at least a

selection of a plurality of client systems communicatively connected to said network to

facilitate said messaging session.

However, Wong teaches an instant messaging server with a plurality of clients

(fig. 2, col. 7, lines 7-19).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Chang and Tang in view of Wong to use a messaging server

communicatively connected to a network, said messaging server for enabling at least

one real time chat messaging session channel via said network between at least a

selection of a plurality of client systems communicatively connected to said network to

facilitate said messaging session. One would be motivated to do so because it enables

much faster electronic communication (col. 1, lines 50-51).

3.   Claims 6, 7, 17, 18, 28, and 29 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chang, Tang, and Wong in view of Rodriguez et al., U.S. Patent No.

6,650,761.

Chang teaches the invention substantially as claimed including a method and

apparatus for securely transmitting transactions from an application program (see

abstract). Tang teaches the invention substantially as claimed including a method and

an apparatus for generating an audio signature for a data item based on a source

identifier associated with the data item (see abstract). Wong teaches the invention

substantially as claimed systems and methods for selecting criteria for a successful

acknowledgment message criteria in instant messaging (see abstract).

As to claims 6, 7, 17, 18, 28, and 29, Chang, Tang, and Wong teach the method,

system, and program of claims 1, 14, and 25.

Chang, Tang, and Wong fail to teach the limitation further including the use of a

graphical and audible watermark.

However, Rodriguez teaches systems using such optical interfaces to control

computers, and to navigate over or act as portals on networks (see abstract).

Rodriguez teaches the use of an audio watermark (col. 44, lines 66-67) and a graphical

watermark (col. 53, lines 51-58).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Chang, Tang, and Wong in view of Rodriguez to use a graphical and

audible watermark. One would be motivated to do so because it would allow for

different options of visible watermarking.

Response to Arguments

4.   In view of the appeal brief filed on March 14, 2006, PROSECUTION IS HEREBY

REOPENED. A new ground of rejection is set forth above.

To avoid abandonment of the application, appellant must exercise one of the

following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

5.   Applicant's arguments, regarding certain claims, filed March 14, 2006 have been fully considered but they are not persuasive.

6.   In response to applicant's arguments for claim 1, the recitation of "at least one server system for enabling at least one real time chat messaging session channel..." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding the argument to claims 1, 14, and 25, the applicant argues that the reference, Chang, does not disclose a digital watermark and that a digital signature only encrypts data for secure transmission. The examiner respectfully disagrees, as seen in, col. 2, lines 20-29, there is a digital signature used to digitally "sign" a message. A

digital signature does not equal encryption. A digital signature is a way to "sign" a

message, which serves the same function as the claimed digital watermark.

7.   In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). This is shown in arguments for claims 1, 14, and 25, regarding limitations

"applying a separate distinguishable watermark to each of a plurality of message

entries" and "recording a log of said chat messaging session."

8.   In response to applicant's argument that there is no suggestion to combine the

references, of Chang and Tang; and of Chang, Tang, and Rodriguez, the examiner

recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). In both cases, the knowledge is generally available to

one of ordinary skill in the art.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

U.S. Pat. No. 6,606,393 to Xie et al.

U.S. Pat. No. 6,754,822 to Zhao

U.S. Pat. No. 6,356,935 to Gibbs

U.S. Pat. No. 6,357,006 to Pham et al.

U.S. Pat. No. 6,625,734 to Marvit et al.

U.S. Pat. No. 5,828,835 to Isfeld et al.

U.S. Pat. No. 6,564,322 to Jameson et al.

U.S. Pat. No. 4,569,015 to Dolev et al.

U.S. Pat. No. 6,760,443 to Lacy et al.

U.S. Pat. No. 6,330,590 to Cotten

U.S. Pat. No. 6,784,901 to Harvey et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG

ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100